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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,986	06/21/2001	Keiichiro Fujie	209669US2TTCRD	3283
22850	7590	10/06/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			DUNN, MISHAWN N	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/884,986	FUJIE ET AL.	
	Examiner	Art Unit	
	Mishawn N. Dunn	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 6/21/01
- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/21/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/21/01</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed on June 21, 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it does not contain a translation. It has been placed in the application file, but the information referred to therein has not been considered as to the merits.

Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enabling disclosure requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is

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unclear as to the exact role of the sending unit and what specific item is being counted.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,6, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyons (US Pat. No. 5,584,050) in view of Takahashi (US Pat. No. 6,463,152).

Consider claim 1. Takahashi teaches an apparatus for recording and reproducing a broadcast program (fig. 1), comprising: a receiver configured to receive program content data broadcasted, the program contents data including viewer response request information (col. 2, lines 55- 58); a memory configured to record the program content data received by said receiver (col. 3, line 1); a decoder configured to decode the program content data in case of reproducing the program content data stored in said memory, and to extract the response request information from the decoded program content data (col. 2, lines 62-65).

In the same field of endeavor, Lyons teaches a sending unit configured to send an item to be counted (col. 5, lines 55-57; fig. 2) in response to the viewer's response to the response request information. Therefore in light of the teaching in Lyons it would have been obvious to include in Takahashi a unit that

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increments a counter by one upon the receiving the viewer's response to determine whether or not the commercial has already been received, decoded, and stored.

Consider claim 6. Claim 6 differs from Takahashi in that the claim further requires a program response information memory configured to store the commercial identify information with a non-response flag if the available day in the commercial identify information is effective and the same commercial identify information is not already stored. Takahashi does not specifically teach that an apparatus for recording and reproducing a broadcast program has program response information memory configured to store the commercial identify information with a non-response flag if the available day in the commercial identify information is effective and the same commercial identify information is not already stored.

However, Lyons teaches that commercial identify information can be stored with a non-response flag if the available day in the commercial identify information is effective and the same commercial identify information is not already stored (col. 6, lines 28-39). Therefore in light of the teaching in Lyons it would have been obvious to include in Takahashi a method of storing the commercial identify information with a non-response flag if the available day is effect and the information is not already stored to be able to readily access and reproduce the commercial identify information.

Method claim 12 is rejected for the same reason as discussed in the corresponding apparatus claim 1 above.

Method claim 17 is rejected for the same reason as discussed in the corresponding apparatus claim 6 above.

6. Claims 2-5, 7-11, 13-16, and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyons (US Pat. No. 5,584,050) in view Takahashi (US Pat. No. 6,463,152) as applied to claims 1 and 12 above, and further in view of Natsubori et al. (US Pub. No. 20010023433).

Consider claim 2. Lyons and Takahashi teach the claimed limitations as stated above in claim 1, except that the program content data includes commercial content data, and the commercial content data includes commercial identify information as the response request information.

However, Natsubori et al. teaches program content data includes commercial content data (pg. 4, para. 0073), and the commercial content data includes commercial identify information as the response request information (fig. 5).

Consider claim 3. Lyons and Takahashi teach all of the claimed limitations as stated above in claim 2, except that the commercial identify information includes a commercial identifier, a server address of a commercial audience response control server, an available day as an effective term, a company name as a commercial sponsor, and a commercial name as a title.

However, Natsubori et al. teaches the commercial identify information includes a commercial identifier, a server address of a commercial audience response control server, an available day, a company, and a commercial name (pg. 5, para. 0091-0092; fig. 8).

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Consider claims 4 and 5. Lyons and Takahashi teach all of the claimed limitations as stated above in claim 3, except that the program content data are previously encoded as a bit stream of each picture by predetermined coding order in case of broadcastly distributing, and the commercial identify information is divided into a plurality of elements as response user data, and each element is sequentially inserted on arbitrary pictures of encoded commercial contents data. Wherein said decoder sequentially extracts each element from the arbitrary picture of decoded commercial content data, and regenerates the commercial identify information by combining the plurality of elements.

Although Natsubori et al. does not specifically teach that each element is sequentially inserted on arbitrary pictures of encoded commercial contents data and said decoder sequentially extracts each element from the arbitrary picture of decoded commercial content data, and regenerates the commercial identify information by combining the plurality of elements. Natsubori et al. does teach that the program content data are previously encoded as a bit stream of each picture by predetermined coding order in case of broadcastly distributing (pg. 5, para. 0079), and the commercial identify information is divided into a plurality of elements as response user data (pg 6., para. 0106). Official notice is taken that it is well known in the art to sequentially insert encoded data, as well as decode sequentially in order to regenerate the information.

Therefore, it would be obvious to one of ordinary skill in the art, at the time the invention was made to use, within an apparatus for recording and reproducing a broadcast program (fig. 1), comprising of a receiver configured to

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receive program content data broadcasted (col. 2, lines 55- 58), a memory configured to record the program content data received by said receiver (col. 3, line 1), a decoder configured to decode the program content data in case of reproducing the program content data stored in said memory (col. 2, lines 62-65), and a sending unit configured to send an item to be counted (col. 5, lines 55-57; fig. 2) in response to the viewer's response as taught by Takahashi and Lyons, the program content data includes a commercial identifier, a server address of a commercial audience response control server, an available day as an effective term, a company name, and a commercial name all encoded as a bit stream of each picture by predetermined coding order in case of distributing, as taught by Natsubori et al., in order to provide a broadcast receiving and playing apparatus to encourage the viewer to watch the commercial program without skipping when recording and reproducing the broadcast program.

Consider claim 7. Lyons and Takahashi teach all of the claimed limitations as stated above in claim 6, except that the apparatus further comprises of a presentation unit configured to inform the viewer of the response request information as the commercial identify information included in the commercial contents data while the commercial contents data is reproducing.

However, Natsubori et al. teaches a presentation unit configured to inform the viewer of the response request information as the commercial identify information included in the commercial contents data while the commercial contents data is reproducing (pg. 5, para. 0085).

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Consider claim 8. Lyons and Takahashi teach all of the claimed limitations as stated above in claim 7, except that the said presentation unit displays a list of the commercial identify information corresponding to the non-response flag, and further comprising a response operation unit configured for the viewer to select the commercial identify information to be responded to from the list.

However, Natsubori et al. teaches that a presentation unit displays a list of the commercial identify information corresponding to the non-response flag (pg. 9, para. 0149), and further comprising a response operation unit configured for the viewer to select the commercial identify information to be responded to from the list (pg.9, para. 0151-0153).

Consider claim 9. Lyons and Takahashi teach all of the claimed limitations as stated above in claim 8, except that the said sending unit creates commercial audience response information including the commercial identifier of the commercial identify information selected by said response operation unit and an identifier of said apparatus for reproducing the commercial contents data.

However, Natsubori et al. teaches that a sending unit creates commercial audience response information including the commercial identifier of the commercial identify information selected by said response operation unit (pg. 10, para. 0161) and an identifier of said apparatus for reproducing the commercial contents data (pg. 10, para. 0162).

Consider claims 10 and 11. Lyons and Takahashi teach all of the claimed limitations as stated above in claim 9, except that the said sending unit sends the commercial audience response information, which additionally includes a user

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identifier of the viewer, to the commercial audience response control server corresponding to the server address in the commercial identify information selected by said response operation unit.

However, Natsubori et al. teaches that a sending unit sends the commercial audience response information, which additionally includes a user identifier of the viewer (pg. 5, para. 0093), to the commercial audience response control server corresponding to the server address in the commercial identify information selected by said response operation unit (pg. 5, para. 0094).

Therefore, it would be obvious to one of ordinary skill in the art, at the time the invention was made to use within an apparatus for recording and reproducing a broadcast program as taught by Takahashi and Lyons as stated above, a presentation unit that displays a list of the commercial identify information corresponding to the non-response flag configured for the viewer to select the commercial identify information to be responded to from the list while the sending unit sends the commercial audience response information, which includes a user identifier of the viewer, to the commercial audience response control server, as taught by Natsubori et al., in order to automatically record a commercial program according to the viewer's response and to display a commercial program as desired by the user when recording and reproducing the broadcast program.

Method claims 13-16 and 18-22 are rejected using similar reasoning as the corresponding apparatus claims 2-5 and 7-11 above.

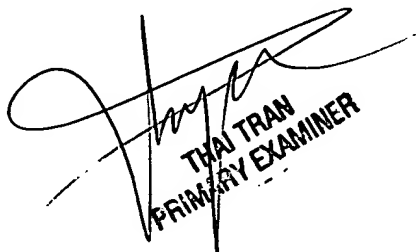
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mishawn N. Dunn whose telephone number is (571)272-7635. The examiner can normally be reached on Monday - Friday 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571)272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



THA TRAN
PRIMARY EXAMINER